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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,774	01/24/2002	William R. Holmberg	1416.35US01	4594
22865	7590	10/08/2004	EXAMINER	
ALTERA LAW GROUP, LLC 6500 CITY WEST PARKWAY SUITE 100 MINNEAPOLIS, MN 55344-7704			SWEET, THOMAS	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 10/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/056,774

**Applicant(s)**

HOLMBERG ET AL.

**Examiner**

Thomas J Sweet

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-38 and 50 is/are allowed.
- 6) ☐ Claim(s) 39, 42, 44, 48 and 51 is/are rejected.
- 7) ☒ Claim(s) 40, 41, 43, 45-47 and 49 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 39 is rejected under 35 U.S.C. 102(b) as being anticipated by Duran (US 5545215). Duran discloses a prosthesis (fig 9) comprising a reinforcement element (20) and a prosthetic conduit (28) of biocompatible material having a cylindrical section effectively ending in an expanded section with the reinforcement element at least a portion of which is positioned circumferentially at the junction there between.

With regard to claim 39, a portion of the reinforcement element 20 is attached proximate to where the conduit ends (one end) and the valve begins but is still downstream from the valve.

Claims 42, 44 and 51 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Klostermeyer et al (US 5891195). See figure 3.

With regards to claim 51, Klostermeyer et al discloses a prosthesis (figure 3) comprising a reinforcement element (52) and a prosthetic conduit (12) comprising biocompatible material, the prosthetic conduit having only a single generally cylindrical section (12) and an expanded section (14 including 36) extending from an end of the generally cylindrical section, wherein the reinforcement element (52) is circumferentially positioned at the junction between the generally cylindrical section and the expanded section.

Claim 48 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Fogarty et al (US 5824037). See figure 3.

***Response to Arguments***

Applicant's arguments, see pages 12-14, filed 07/06/2004, with respect to claim 1 have been fully considered and are persuasive. The rejection under 35 U.S.C. 102(b) of claim 1 and dependent claims 2-6, 9-11, 13, 15-16, 18-19, 21, 23 and 26 has been withdrawn.

Applicant's arguments, see page 18, filed 07/06/2004, with respect to claim 14 have been fully considered and are persuasive. The rejection under 35 U.S.C. 103 of claim 14 has been withdrawn.

Applicant's arguments filed 07/06/2004 with respect to claims 42 and 44 have been fully considered but they are not persuasive. Klostermeyer does clearly anticipate claim 42 as seen in figure 3. A prosthesis (fig. 3) comprising a first prosthetic conduit section (18) and a second integral (i.e. connected) prosthetic conduit section (20) wherein the inflow edge of the first prosthetic conduit section is configured for attachment to the outflow edge of the second prosthetic conduit section (the so call "cone shaped" section down to the section as 34), the first prosthetic conduit section having a generally cylindrical section (despite the corrugations it is generally cylindrical) and the second prosthetic conduit section comprising a prosthetic valve(22). Applicant is arguing a moot point that the prosthetic conduit section (18) of Klostermeyer is not cylindrical when the claim clearly states generally cylindrical.

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Applicant's arguments filed 07/06/2004 with respect to claim 48 have been fully considered but they are not persuasive. Fogarty does clearly anticipate claim 48 as seen in figure 3. A prosthesis (fig. 3) comprising a reinforcement element (62, stent) and a prosthetic conduit (64) comprising biocompatible material, wherein the reinforcement element is circumferentially attached (at 74) to the prosthetic conduit proximate to the outflow edge (also at 74). Applicant's argument that Fogarty's engaging and sealing element is not a reinforcement element is not persuasive since the engaging and sealing element reinforces against movement and leakage.

***Allowable Subject Matter***

Claims 1-38 and 50 are allowed.

Claims 40-41, 43, 45-47 and 49 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

This is a Request for Continued Examination. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J Sweet whose telephone number is (703) 308-4018. The examiner can normally be reached on 6:30 am - 5:00pm, M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine M McDermott can be reached on (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tjs

  
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